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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,774	02/06/2004	Gunther Durhammer	283-4 CIP	7901
23869	7590	10/13/2006	EXAMINER	
Hoffmann & Baron, LLP			EDEL, JOHN B	
6900 JERICHO TURNPIKE				
SYOSSET, NY 11791			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/773,774	DURHAMMER, GUNTHER
	<b>Examiner</b>	<b>Art Unit</b>
	John B. Edel	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 February 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. 09/522,877.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Priority***

(1)

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/522,877, filed on March 10, 2000.

***Drawings***

(3)

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

***Specification***

(3)

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Water repellent cigarette paper."

***Claim Rejections - 35 USC § 103***

**(4)**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,722,433 to Ishino et al. ("Ishino") in view of United States Patent No. 2,091,572 to J. H. Swan ("Swan").

Regarding Claim 1: Ishino discloses applying a cellulose derivative to paper (col. 10 lines 15-16). Ishino fails to disclose a first and second application of the paper coating separated by drying step. Swan discloses applying coatings to paper in a multi-step process including a first application followed by drying followed by a second application (page 1 col. 2 and all of page 2). Ishino and Swan are analogous because they both come from the art of coating paper. It would be obvious to combine the multiple coating

technique of Swan with the coating methods of Ishino because multiple coatings commonly result in better coverage than single coatings.

Regarding Claim 2: Ishino additionally discloses Ethyl cellulose as the cellulose derivative (col. 10 lines 15-16).

Regarding Claim 3: Ishino additionally discloses concentrations of the coating varying within the ranges of 0.1 to 30 g/m<sup>2</sup> (col. 10 line 40-45).

Regarding Claim 4: Ishino additionally discloses coating one or both sides of the paper (col. 10 lines 27-31).

Regarding Claim 5: Figure 1 of Swan discloses a dual coating being administered to the same side of the paper.

Regarding Claim 6: Additionally, application by a coating roller in a gravure process is shown in figure 1 of Swan (page 1 col. 2 lines 45-50; page 2 col. 2 lines 1-13).

Regarding Claim 7: Ishino additionally discloses air permeability in excess of 20 Coresta units (col. 10 lines 35-40).

Regarding Claim 8: Ishino additionally discloses coating paper with the mixture (impregnating) (col. 10 lines 25-30), that the sheet is water dispersible (water repellent)(abstract).

Regarding Claim 9: The limitations of this claim are addressed in the treatment of claim 3.

Regarding Claim 10: The limitations of this claim are addressed in the treatment of claim 6.

Regarding Claim 11: The limitations of this claim are addressed in the treatment of claim 1.

Regarding Claim 12: The limitations of this claim are addressed in the treatment of claim 2.

Regarding Claim 13: The limitations of this claim are addressed in the treatment of claim 3.

Regarding Claim 14: The limitations of this claim are addressed in the treatment of claim 4.

Regarding Claim 15: The limitations of this claim are addressed in the treatment of claim 5.

Regarding Claim 16: The limitations of this claim are addressed in the treatment of claim 6.

Regarding Claim 17: The limitations of this claim are addressed in the treatment of claim 7.

Regarding Claim 18: In addition to the limitations recited in the treatment of claim 1 Ishino discloses a cigarette (abstract) using the sheets described therein. It is notoriously well known in the art of cigarette manufacture that cigarettes contain tobacco strands. Also, the dual coating as treated in claim 5 would inherently result in at least two layers being formed on the paper.

Regarding Claim 19: The limitations of this claim are addressed in the treatment of claim 2.

Regarding Claim 20: Ishino additionally discloses air permeability in excess of 50 Coresta units (col. 10 lines 35-40).

Regarding Claim 21: The limitations of this claim are addressed in the treatment of claim 4.

Regarding Claim 22: The limitations of this claim are addressed in the treatment of claim 3.

Regarding Claim 23: The limitations of this claim are addressed in the treatment of claim 6.

Regarding Claim 24: It would have been obvious to one having ordinary skill in the art at the time of the invention to use only a single layer of paper to hand roll a cigarette hand rolling being notoriously well known in the art of cigarette making. The motivation for doing so is that hand rolling a cigarette among the simplest method for assembling a cigarette.

Regarding Claim 25: The limitations of this claim are addressed in the treatment of claims 1, 2, 7, and 8. (8 addresses water repellent nature, 2 show ethyl cellulose, 1 addresses two layers of cellulose derivative, and 7 addresses the Coresta requirements)

Regarding Claim 26: The limitations of this claim are addressed in the treatment of claim 2.

Regarding Claim 27: The limitations of this claim are addressed in the treatment of claim 20.

Regarding Claim 28: The limitations of this claim are addressed in the treatment of claim 4.

Regarding Claim 29: The limitations of this claim are addressed in the treatment of claim 3.

Regarding Claim 30: The limitations of this claim are addressed in the treatment of claim 6.

Regarding Claim 31: The limitations of this claim are addressed in the treatment of claim 24.

Therefore it would have been obvious to combine Swan with Ishino to obtain the invention as specified in Claims 1-31.

***Conclusion***

(5)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Edel whose telephone number is (571) 272-4804. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBE

*Eric Hug*  
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PRIMARY EXAMINER